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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/637,664	08/11/2003	Makoto Izumi	57810-072	3514
7590 12/15/2004				
McDERMOTT, WILL & EMERY				
600 13th Street, N.W.				
Washington, DC 20005-3096				
		EXAMINER		
		BREWSTER, WILLIAM M		
		ART UNIT PAPER NUMBER		
		2823		

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/637,664

Applicant(s)

IZUMI ET AL.

Examiner

William M. Brewster

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 13-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. 120904.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### Generally

Applicant's request for reconsideration of the finality of the rejection of the Office action sent 17 November 2004 is persuasive and, therefore, the finality of that action is withdrawn.

The following rejection has been incorporated by reference from the non-final rejection, and is represented here for convenience:

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atsushi, JP Publication No. 10-229180 in view of DiLoreto et al., U.S. Patent No. 6,076,933.

Atsushi teaches a solid state image device comprising: in fig. 2, an optical lens 24; a solid state image sensor 16, 17 including a microlens 22; and a layer 19 (a light filter) formed between said optical lens and said microlens of said solid state image sensor, p. 4, ¶ 22;

limitations from claim 2: in fig. 2, wherein said optical lens and said microlens of said solid state image sensor are integrally formed through said layer, p. 4, ¶ 22; limitations from claims 4, 5, 6: wherein said microlens of said solid state image sensor includes: a first film having an upwardly projecting shape, and a second film, formed on said first film, having an upwardly projecting shape reflecting said upwardly projecting shape of said first film; wherein said first film and said second film are made of materials having the same refractive index; wherein said first film and said second film are formed by SiN films (film 22 formed from the original layer 21 SiN), p. 4, ¶ 22; in fig. 2, wherein examiner interprets 22 as having two layers of the same refractive index wherein the boundary is not shown between them;

limitations from claim 3: with said microlens of said solid state image sensor has a refractive index of 2.0;

limitations from claims 7-8, in fig. 2, wherein said first film is formed with a plurality of said upwardly projecting shapes at prescribed intervals, peaks of 22, and said second film 18 is formed with a plurality of said upwardly projecting shapes to fill up gaps of said first film; wherein each adjacent pair of said upwardly projecting shapes of said second film are connected with each other to include no substantially flat region on the boundary therebetween.

Atsushi does not specify whether the layer between the optical lens and the microlens contains resin, but rather specifies it is an image filter. DiLoreto teaches an

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image filter with resin. DiLoreto teaches in figs. 4-6, an image filter with resin 62, col. 7, lines 17-27, wherein image filter contains a refractive index of approximately 1.5, col. 7, line 56-col. 8, line 12. DiLoreto gives motivation in col. 2, lines 28-45. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to recognize that combining DiLoreto's process with Atsushi's invention would have been beneficial because it provides improved optical properties.

For claim 9, Atsushi does not specify the thickness of the second film, but the practitioner may optimize this dimension.

"Normally, it is to be expected that a change in temperature, or in concentration, or in both, would be an unpatentable modification. Under some circumstances, however, changes such as these may impart patentability to a process if the particular ranges claimed produce a new and unexpected result which is different in kind and not merely degree from the results of the prior art . . . such ranges are termed 'critical ranges' and the applicant has the burden of proving such criticality . . . More particularly, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation."

In re Aller 105 USPQ 233, 255 (CCPA 1955). See also In re Waite 77 USPQ 586 (CCPA 1948); In re Scherl 70 USPQ 204 (CCPA 1946); In re Irmischer 66 USPQ 314 (CCPA 1945); In re Norman 66 USPQ 308 (CCPA 1945); In re Swenson 56 USPQ 372 (CCPA 1942); In re Sola 25 USPQ 433 (CCPA 1935); In re Dreyfus 24 USPQ 52 (CCPA 1934).

Note that the specification contains no disclosure of either the critical nature of the claimed dimensions of any unexpected results arising there from. Where

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patentability is aid to be based upon particular chosen dimensions or upon another variable recited in a claim, the Applicant must show that the chosen dimensions are critical. In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990).

Claims 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atsushi in view of DiLoreto as applied to claims 1-9 above, and further in view of Needham.

Needham teaches the solid state image device according to claim 1, fig. 6, further comprising a recessed third film 18 formed on said solid state image sensor, wherein said microlens of said solid state image sensor includes a fourth film 20, embedded in the recessed portion of said third film, SiO<sub>2</sub>, exhibiting a larger refractive index than said third film and having a downwardly projecting shape; wherein said fourth film is formed by an SiN film. Needham gives motivation in the Abstract. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to recognize that combining Atsushi's and DiLoreto's process with Needham's invention would have been beneficial because it improves the quantum efficiency.

Claims 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atsushi in view of DiLoreto and Needham as applied to claims 1-11 above, and further in view of Wolf, V. II, p. 229-232.

Atsushi, DiLoreto, and Needham do not specify the use of SOG. Needham does specify the use oxide for the third layer, but does not specify SOG. Wolf specifies using

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SOG for an oxide layer and gives motivation in p. 229, bottom ¶. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to recognize that combining Wolf's process with Atsushi, DiLoreto, and Needham's invention would have been beneficial because it has simpler processing and lower defect density.

### ***Response to Arguments***

Applicant's arguments filed 2 November 2004 have been fully considered but they are not persuasive. Applicant argues Kuroiwa Atsushi teaches a microlens, but fails to teach an optical lens and that a microlens is different from an optical lens.

Examiner respectfully disagrees that the two terms are necessarily distinguished in the prior art. Proffered as evidence, Suzuki et al., US Patent No. 4,877,717, in col. 1, lines 15-26 teaches, "microlenses or micro optical lenses have various uses." Suzuki further teaches that these micro optical lenses or microlenses have a short focal length and, as one cited example, may be used in integrated optical circuits. As Suzuki, holder of a US Patent defines that microlenses are small or micro optical lenses, Kuroiwa Atsushi's structure labeled 24, which he refers to as a microlens may also be reasonably viewed as an optical lens by one of ordinary skill in the art. While there may be some differences between the application's specification and the prior art of record, the USPTO tasks the examiner with interpreting the claims broadly as reasonably permitted by one of ordinary skill in the art.

Examiner must give claims their broadest reasonable interpretation, MPEP §2111, "During patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification.' Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified, *In re Pratter*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969), *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997)." Also see *In re Zletz*, 13 USPQ 2d. 1320 (Fed. Cir. 1989).

For these reasons, the rejection is proper.

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.




Any inquiry concerning this communication or earlier communications from the examiner should be directed to William M. Brewster whose telephone number is 571-272-1854. The examiner can normally be reached on Full Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Olik Chaudhuri can be reached on 571-272-1855. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

9 December 2004  
WB

  
Olik Chaudhuri  
Supervisory Patent Examiner  
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